PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Alan Goldsmith, et al.

Application No.: 09/943,613 Examiner: Robert E. Pezzuto

Filed: August 30, 2001 Docket No.: A0621-US-NP
XERZ 2 00426

For: **ON-SITE E-COMMERCE PARTS ORDERING FROM PRODUCTS BEING SERVICED**

CORRECTED BRIEF ON APPEAL

Appeal from Group 3671

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application Xerox Corporation, by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 012142, Frame 0657.

II. RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

The status of the claims set forth after the Advisory Action mailed March 22, 2005 is as follows:

Allowed Claims: none

Rejected Claims: 1 and 3-21

The present appeal is directed specifically to claims 1 and 3-21.

IV. STATUS OF AMENDMENTS

No Amendment After Final Rejection has been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Applicant's claims are directed toward a method and a system for ordering parts for a machine being serviced within an e-commerce environment by transmitting diagnostic data from a local computing device at the machine to a host computing device via a network.

Claim 1 defines a method for ordering parts for a machine being serviced within an e-commerce environment. A local computing device **12** at a machine **10** transmits diagnostic data **1020** to a host computing device **20** via a network **22**. The host computing device **20** processes the data **1022** to identify a part **24** within the machine **10** to be replaced. The part **24** to be replaced is identified as either a non-replaceable or replaceable component. The host computing device **20** determines a part identifier **1030** as a function of stored part and retrofit information. The host computing device **20** then transmits the part identifier **1038** to an order processing device **40**.

Claim 3 further defines the method of claim 1. The host computing device **20** determines other parts within the machine to be replaced as a function of the first replaced part, since changing one part in the machine may precipitate changing other parts.

Claim 8 also further defines the method of claim 1. Once the host computing device **20** identifies a part to be replaced, a display device **30** on the machine **10** displays a graphical representation of the machine and zooms in on the graphical representation via a pointing device.

Claim 9 defines a method for communicating an order for a replacement part from a serviced product to a remote location via a network. A local processing unit

transmits diagnostic data to a central processing unit **38** via the network **22**. The central processing unit **38** processes the data **1022** and determines if one or more parts **24** on the machine **10** need to be replaced. If one or more parts **24** need to be replaced, the central processing unit **38** further identifies a part number for the replacement part, determines if the part is replaceable or not, and orders the replacement part **1038**.

Claim 13 further defines the method of claim 9. The process of identifying a part number includes selecting a part from an illustration of the product, displayed on a monitor **30** and zooming in on the product to further identify the part.

Claim 15 defines a system for ordering parts for a machine. A diagnostic data transmission arrangement is configured to transmit data from a local device **12** at a machine **10** to a remote computing device **20** via a network **22**. An identification arrangement is configured to identify a part **24** to be replaced as a function of the diagnostic data. A storage device **34** communicates with the host computing device **20** for storing retrofitting information for the part **24**. A processor **38** on the host computing device **12** updates **1034** retrofit information on the part **24** and transmits an order **1038** for the part **24** to an order processing center **40** if the part is not current.

Claim 17 further defines the system of claim 15. The central processing unit **12** determines additional parts in the machine to be replaces as a function of the identified part **24**.

Claim 18 further defines the system of claim 15. A machine identifier is transferred **1032** from the local computing device **12** to the host computing device **20**

via the network **22**. The central computing device **20** then determines the part and retrofit information as a function of the machine identifier.

Claim 20 further defines the system of claim 15. The system includes a display device **30** for illustrating a graphical representation of the machine **10**, and a pointing device for zooming the graphical representation and selecting the part **24**.

Claim 21 further defines the method of claim 8. The data for the graphical representation **30** of the machine **10** includes the part identifier.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

Claims 1 and 3-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuire et al. (U.S. Patent No. 4,404,639).

VII. ARGUMENT

Claims 1 and 3-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McGuire et al. Appellants respectfully traverse. This is the only outstanding rejection or objection.

A. The Examiner's Rejection of Claims 1 and 3-21 as Being Unpatentable over McGuire et al. Is Erroneous and Must Be Reversed.

1. The Office Action of March 22, 2005 Incorrectly States That Appellants' Submitted Only One Argument Against the Outstanding Rejections

In the Office Action of March 22, 2005, on page 2, it was argued, "[i]t appears that the only argument is contained on page 8 of Applicants' response . . . ."

This argument was directed to whether or not manual steps would still be required in the teaching of McGuire et al., and whether this is a distinguishing feature.

The position that only a single argument for patentability was presented in Appellants' December 23, 2004 reply is respectfully traversed, and the Examiner's comments indicate that full consideration of the response was not presented. More specifically, Appellants request review of the Amendment dated December 23, 2004 to confirm this position. Particularly, in the first line of page 8 of the December 23, 2004 Amendment, it is stated, "[f]urther, McGuire et al. does not teach determining whether the non-replaceable component(s) is part of a replaceable sub-assembly, and, then identifying the part as the sub-assembly for replacement purposes, as in claim 1." Additionally, it is stated on page 8, "[t]herefore, the present application actually is performing the ordering of the replacement part(s), whereas McGuire et al. does not teach the ordering process, providing the needed information to replace the part(s), and

identifying the retrofit information of the replaceable part(s)." Still further on page 8, in a discussion regarding a graphical representation of the machine on the display device as taught in the present application and claimed therein, it is stated, "It is submitted the cited references do not provide for this same type of part identification, as illustrated by claims 8, 13, 20, and newly added claim 21."

For at least these reasons, it is clear Appellants have made arguments well beyond that cited by the Examiner.

2. McGuire et al. Does Not Teach or Fairly Suggest the Component Sub-Assembly Claimed Concepts

Claim 1 of the present application recites a method for ordering parts in an e-commerce environment where diagnostic data is transmitted to a host computing device allowing the identification of a part(s) to be replaced within the machine. Included in the identification step is identifying the part to be replaced as either a non-replaceable component in a replaceable sub-assembly or as a replaceable component part. The part identified to be replaced may be a replaceable component within the machine. For example, the part may be a piece that is capable of being removed from the machine and/or replaced as a discrete element, in which case the part identifier represents the component to be replaced. Alternatively, the part may be included as a non-replaceable component within a replaceable sub-assembly, in which case the part cannot be removed and/or replaced within the machine without removing and/or replacing an entire sub-assembly. In this case, the part identifier would represent the entire sub-assembly including the part to be replaced. McGuire et al. does not teach or fairly suggest determining whether a non-replaceable component(s) is part of a replaceable sub-assembly, and, then identifying the part as the sub-assembly, for

replacement purposes, as in claim 1. It is noted similar limitations are found in claims 9 and 16.

The capability of determining that a non-replaceable component is part of a replaceable sub-assembly provides a benefit not achieved by McGuire et al. Particularly, attempting to best analogize McGuire et al. to the present concepts, if the McGuire et al. system determines a component needs to be replaced, the repair person would then contact the parts ordering department in an attempt to order the part. However, the repair person might be informed that not only does that part need to be replaced, but also an entire larger sub-assembly, and that it is not possible to replace that part alone. Then, the user (in McGuire et al.) would need to inform the customer that it is not just a single part, an entire sub-assembly is necessary, increasing the cost to the user. Using the concepts of the present application as claimed, it would be immediately known that it is a sub-assembly which needs to be replaced. Having this information increases the efficiency, decision making and productivity of the repair process. Such capabilities and improvements are not possible under McGuire et al.

3. McGuire et al. Does Not Teach or Fairly Suggest Use of Retrofit Information to Determine Additional Parts to be Replaced

In addition, the present application teaches and claims determining whether replacing one part in the machine requires changing another part, and any additional parts to be replaced are identified as a function of the part to be replaced, as recited by claims 1, 3, 9 and 17. As explained on page 7 of the application, change-tag information will identify other parts that are to be replaced, along with the particular part in question. Thus, replacing one part in the machine may precipitate changing another part. Any additional parts to be replaced are identified within retrofit information.

Therefore, the present application actually is performing the ordering of the replacement part(s), whereas McGuire et al. does not teach or fairly suggest the ordering process, providing the needed information to replace the part(s), or identifying the retrofit information of the replaceable part(s).

4. McGuire et al. Does Not Teach or Fairly Consider the Use of Retrofit Information to Obtain Updates

A further distinction with regard to the retrofit information is that the retrofit information also includes change information as to whether a part has become obsolete. The part identifier will be updated as a function of the retrofit information. More particularly, a processing device 38, which communicates with the host computing device 20, determines if any updated information is available for the part identifier. Then this updated information is used to order a part which has replaced the now obsolete part. At least claims 15 and 18 address the use of the retrofit information for identifying a part as an updated part. This is a valuable unique novel distinction, as it permits the system to automatically provide updated parts to a obsolete part.

Consequently, since McGuire et al. does not include the above limitations, the claimed subject matter is rendered unobvious over the prior art. These limitations regarding identifying the proper part(s) to be replaced and whether they are part of an assembly, need to be updated per retrofit information, or further determine that additional parts need to be replaced are important elements of the present invention that are not taught in McGuire et al.

5. McGuire et al. Does Not Teach or Fairly Suggest Use of a Graphical Representation for Part Ordering

The claims of the present application also permit for a part to be identified by viewing a graphical representation of the machine on a display device, then, via a pointing device, the user can point to an area on the monitor displaying a section of the machine including the part and part identifier (e.g., part number) information. The user can then magnify that portion of the machine and select the part to be replaced. It is submitted the cited reference does not provide for this same type of part identification, as illustrated by claims 8, 13, 20, and 21.

6. McGuire et al. Does Not Teach or Fairly Suggest the Automated Concepts of the Present Application

Additionally, the Appellants respectfully disagree with the Examiner's position pertaining to automating the manual steps. Regardless of the fact that the reference is more than 20 years old and that there have been advances within the computer and e-commerce field, the present claims are not obvious in view of McGuire et al. The Examiner had cited *In re Venner*, for the position that providing an automatic means to replace a manual activity, which accomplishes the same result, is not an invention, to show that automating certain steps in McGuire et al. would have been obvious to one having ordinary skill in the art. However, Appellants strongly disagree with this. Even if several of the manual steps in McGuire et al. could now be automated, it would still be necessary for some amount of manual entry (col. 3, lines 44-52; col. 4, lines 58-66; col. 10, lines 51-64; col. 11, lines 1-19 and 37-40; col. 12, lines 40-42), so it would have not been obvious to one having ordinary skill in the art to completely automate these steps. Whereas, the present application teaches a method for ordering parts that reduces the potential of human error in the process (page 2, lines 19-25).

The Appellants point out that the present application and McGuire et al. have important differences, as noted above, and continue to traverse with the Examiner's comments. Therefore, it is respectfully submitted that claims 1 and 3-21, including independent claims 1, 9 and 15 are distinguished from the cited art.

CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1 and 3-21 are in condition for allowance. For all of the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of claims 1 and 3-21.

Respectfully submitted,

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APPENDICES

VIII. CLAIMS APPENDIX

Claims involved in the Appeal are as follows:

1. A method for ordering parts for a machine being serviced within an e-commerce environment, the method comprising:

transmitting diagnostic data from a local computing device at the machine to a host computing device via a network;

identifying a part to be replaced within the machine as a function of the diagnostic data, wherein

when the part is included as a non-replaceable component in a replaceable sub-assembly within the machine, the identifying step further includes,

identifying the part as the sub-assembly, and

when the part is a replaceable component within the machine, the identifying step further includes,

identifying the part as the component;

determining a part identifier as a function of the part and retrofit information stored on the host computing device; and

transmitting the part identifier from the host computing device to an order processing device.

3. The method for ordering parts as set forth in claim 1, further including:

determining other parts within the machine to be replaced as a function of the part identifier, since replacing one part in the machine may precipitate changing another part, and any additional parts to be replaced are identified within the retrofit information as a function of the part to be replaced.

4. The method for ordering parts as set forth in claim 1, further including:

transmitting an identifier of the machine from the local computing device to a host computing device via the network, the part identifier and the retrofit information being identified as a function of the machine identifier.

5. The method for ordering parts as set forth in claim 1, wherein the local computing device is a discrete unit from the machine, the method further including:

connecting the local computing device to the machine via a communication link.

6. The method for ordering parts as set forth in claim 1, further including:

storing the diagnostic data within the local computing device.

7. The method for ordering parts as set forth in claim 1, further including:

transmitting a confirmation to the local computing device that the part identifier has been transmitted to the order processing device.

8. The method for ordering parts as set forth in claim 1, wherein the identifying step includes:

viewing a graphical representation of the machine via a display device; and

zooming-in the graphical representation, via a pointing device.

9. A method for communicating an order for a replacement part from a product being serviced to a remote location via a network, the method comprising:

transmitting diagnostic data for the product from a local processing unit to a central processing unit via the network;

processing the diagnostic data at the central processing unit for determining if one of a plurality of parts included in the machine is to be replaced;

identifying an original part number for the part to be replaced;

determining the replacement part as either a replaceable component part or as a non-replaceable component within a replaceable sub-assembly, as a function of the original part number and retrofit information, which substitutes for the part to be replaced; and

ordering the replacement part.

10. The method for communicating an order for a replacement part as set forth in claim 9, further including:

transmitting a confirmation, which indicates that the replacement part has been ordered, from the central processing unit to the local processing unit.

11. The method for communicating an order for a replacement part as set forth in claim 9, further including:

producing the diagnostic data within the local processing unit.

12. The method for communicating an order for a replacement part as set forth in claim 9, further including:

maintaining the retrofit information on the central processing unit.

13. The method for communicating an order for a replacement part as set forth in claim 9, wherein the identifying step includes:

selecting the part from an illustration of the product displayed on a monitor, and zooming-in on the illustration to further identify the part.

14. The method for communicating an order for a replacement part as set forth in claim 13, wherein the selecting step includes:

selecting successively detailed illustrations of the product; and

selecting the part from one of the illustrations having a predetermined level of detail.

15. A system for ordering parts for a machine, comprising:

a diagnostic data transmission arrangement configured to transmit diagnostic data from a local computing device at the machine to a remote host computing device via a network;

an identification arrangement configured to identify a part to be replaced within the machine as a function of the diagnostic data which is processed by the host computing device;

a storage device communicating with the host computing device for storing retrofit information; and

a processor within the host computing device for ensuring the part is current in accordance with the retrofit information, the processor identifying the part as an updated part if the part is not current and transmitting an order for the part from the host computing device to an order processing center.

16. The system for ordering parts as set forth in claim 15, wherein:

if the part is included as a non-replaceable component in a replaceable sub-assembly within the machine, the part being identified as the sub-assembly; and

if the part is a replaceable component within the machine, the part being identified as the component.

17. The system for ordering parts as set forth in claim 15, wherein:

determining additional parts in the machine to be replaced as a function of the part identified to be replaced.

18. The system for ordering parts as set forth in claim 15, wherein:

an identifier of the machine is transmitted from the local computing device to a host computing device via the network, the part and the retrofit information being identified as a function of the machine identifier.

19. The system for ordering parts as set fort in claim 15, further including:

a communication link connecting the local computing device to the machine; and

a storage device within the local computing device for storing the diagnostic data.

20. The system for ordering parts as set forth in claim 15, wherein the means for identifying includes:

a display device for illustrating a graphical representation of the machine; and

a pointing device for a) zooming the graphical representation until the part is magnified to a predetermined threshold and b) selecting the part.

21. The method for ordering parts as set forth in claim 8, wherein data for the graphical representation of the machine includes the part identifier.

IX. EVIDENCE APPENDIX

NONE

X. RELATED PROCEEDINGS APPENDIX

NONE